

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent of:

Yoshihiro Suzuki et al.

Confirmation No.: 3652

Patent No.: 6,561,716

Art Unit: 3671

Filed: June 1, 2000

Examiner: Robert Pezzuto

For: UNIVERSAL JOINT DEVICE AND METHOD  
OF MANUFACTURING THE DEVICE

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Issued Date: May 13, 2003

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF  
MAINTENANCE FEES IN EXPIRED PATENT**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a petition to accept payment of maintenance fees for U.S. Patent No. 6,561,716 ("the '716 patent") after expiration of the patent, wherein the delay in payment of the maintenance fees was unavoidable. *See* 37 CFR §1.378(b). The required maintenance fee owed under 37 CFR §§1.20(e)-(f) (\$980) and the surcharge owed under 37 CFR §1.20(i)(1) (\$700) are submitted concurrently herewith by authorization to deduct these amounts from Deposit Account No. 50-4570. As shown below, all of which is based upon information and belief, the delayed payment was unavoidable since reasonable care was taken to ensure that the maintenance fees would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

**Steps Taken To Ensure Timely Payment  
Of The Maintenance Fee**

The '716 patent issued on May 13, 2003 and the first maintenance fee for this patent could have been paid during the period from May 13, 2006 to November 13, 2006. The fee also

could have been paid with a surcharge during the period from November 13, 2006 through May 13, 2007. The fee was not paid and accordingly, the patent expired after midnight on May 13, 2007

The assignee of the patent is Kabushiki Kaisha Somic Ishikawa of Tokyo Japan ("Somic Ishikawa"). Its patent affairs are handled in Japan by Kabasawa & Associates of Tokyo Japan ("Kabasawa"). Kabasawa engaged the firm of Darby & Darby ("Darby") to prosecute the patent application which led to the patent in the United States and to be responsible for paying maintenance fees in the U.S.

As of 2005 Darby had been in business as an intellectual property firm with a significant U.S. Patent prosecution practice for 110 years. It had a separate department of the firm which handled maintenance and annuity fees. The department had an experienced manager and from four to five paralegals. It also had well established and time-tested procedures for assuring that maintenance fees were timely paid. It included a docketing system that would notify the maintenance and annuity fee paralegals as well as the working, supervising and billing attorneys if a due date was approaching.

As of March 31, 2010, Darby ceased the practice of law. As a result it has been difficult getting information and documentation for this petition.

Near the end of 2005 Darby sent to Kabasawa a list of patents in which annuities were due in the 4<sup>th</sup> Quarter of 2006. The '716 patent was on the list.

By May 21, 2006 Kabasawa had returned the list to Darby with an indication that the maintenance fee for the '716 patent should be paid. A copy of the list is attached as **Exhibit A**.

One of the paralegals, Perry Moy, was assigned to handle the payment. Mr. Moy was well trained in the procedures that had been established and had paid numerous maintenance fees in the past without incident. He followed the existing procedures to a point. In particular, he updated the docketing system to indicate that the payment had been made. Attached as **Exhibit B** is a printout of the docket for this patent indicating that the first maintenance fee was paid on

July 27, 2006. He also notified accounting of the payment. As a result, an invoice was issued to Kabasawa for payment of the fee. A copy of the invoice for the fee dated August 31, 2006 is attached as **Exhibit C**. The one critical thing that Mr. Moy forgot to do was to notify MDC, the maintenance fee company used by Darby, that they should effect payment of the fee.

Thus, as of August 31, 2006, everyone at Darby assumed the fee had been paid as reflected by the updated docket system. Kabasawa and Somic Ishikawa assumed it had been paid because that was their instruction and they were billed for the service.

With Darby no longer being in business and the second maintenance fee coming due on May 13, 2010, Kabasawa began to look into alternative ways of getting the fee paid. In October 2010, Kabasawa checked public PAIR and learned for the first time that the patent had expired in 2007 for non-payment of the first maintenance fee. However, Kabasawa no longer had a contact at Darby whom they could question about the situation.

Eventually on October 20, 2010, Kabasawa contacted the Dissolution Committee of Darby to inquire as to what happened. A copy of an e-mail to the Dissolution Committee is attached as **Exhibit D**. The undersigned is a member of the Dissolution Committee.

After an investigation that was as complete as possible, considering that Darby has only a small staff for collecting accounts receivables, and not part of the former maintenance fee department, the undersigned agreed to submit this petition.

**Legal Principals That Support Acceptance of This  
Late Payment of Maintenance Fee**

Under 35 U.S.C. § 41(b), the Director may accept late payment of a maintenance fee if the delay in payment is shown to have been "unavoidable." To satisfy the "unavoidable" standard, "one must show that he exercised the due care of a reasonably prudent person," *Ray v. Lehman*, 55 F.3d 606, 609 (Fed. Cir. 1995). This legal standard was also addressed in *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. App. 1912), which explains the meaning of the word "unavoidable" in the context of delayed maintenance fee payments as follows:

It is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them, in the exercise of this care, to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all the other conditions of good faith and promptness in its ratification being present.

To paraphrase, if a patentee relies upon “the ordinary and trustworthy agencies of mail,” “worthy and reliable employees,” and “other means and instrumentalities” that are usually employed by “prudent and careful men in relation to their most important business,” and a failure occurs “unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities,” such failure may be said to have been “unavoidable” if all other “conditions of good faith and promptness” are present.

Here the assignee Somic Ishikawa and its agent Kabasawa relied in good faith upon these types of trustworthy and reliable means and instrumentalities. In particular, they provided clear instructions to Darby, a firm in business for 110 years, and a firm they could reasonably consider trustworthy and reliable. Further they received confirmation that their instructions to pay the fee had been carried out.

Darby had in place procedures for payment of maintenance fees and a staff dedicated to that process. However, a single human error caused a failure to pay the fee and disabled the backup features. If Mr. Moy had merely forgotten to pay the fee, docket notices would have warned the attorneys assigned to the case and the manager of the department that the fee was not paid. If he had not notified accounting that the fee was paid, the billing attorney may have noticed and outstanding fee. Thus, the error cause harm not because of a human mistake in failing to notify MDC to pay the fee, but in completing the rest of the procedure.

#### **Payment of the Second Maintenance Fee**

The deadline for paying the second maintenance fee is November 13, 2010, without surcharge, and amounts to (\$2480). The office is authorized to deduct this amount from Deposit Account No. 50-4570.

## Conclusion

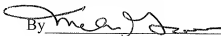
Given the foregoing, the patentee hereby respectfully submits that the entire delay in paying the first (fourth year) maintenance fee for the '716 patent was unavoidable because it resulted from a single human error by a trusted employee of a firm in which the patentee could reasonably have trusted. Also, the failure to notice that the fee had not been paid was unavoidable because of the indications provided to the patentee that the fee had been paid. Accordingly, the patentee respectfully requests that this petition be granted, allowing the delayed payment of the fourth year maintenance fee to be accepted, and for the '716 patent to be reinstated.

Since the window for paying the eighth year maintenance fee without surcharge for the '716 patent closes on November 13, 2010, this Petition is being submitted concurrently with a payment of the second (eighth year) maintenance fee owed under 37 CFR §§1.20(e)-(f) for this patent.

If the U.S. Patent and Trademark Office determines that any additional fees are required, the Commissioner is hereby authorized and requested to charge any deficiency owed, and/or credit any refund due, to Deposit Account No. 50-4570.

Dated: April 5, 2011

Respectfully submitted,

By 

Melvin C. Garner

Registration No.: 26,272

LEASON ELLIS LLP

81 Main Street

White Plains, New York 10601

(914) 821-8005

(914) 288-0023 (Fax)

Attorneys/Agents For Patentee

# EXHIBIT A

Return to: Polly Stevens  
Fax: (212) 527-7701  
Number of Pages: \_\_\_\_\_

**Darby & Darby, PC Annuity Payment Authorization List/Worksheet**  
**Annuitants Due 4th Quarter 2006**  
**Client Number: 09450 - Kabasawa & Associates**

United States	Yoshitomo SUZUKI	6,561,716	000000313	11/18/2006	\$ 1212	<input checked="" type="checkbox"/> Pay
Title: UNIVERSAL JOINT DEVICE AND METHOD OF MANUFACTURING THE DEVICE				Tax Year: 4	Entity: Large	<input type="checkbox"/> Do not pay
Our Ref: 000689-JSD					<input type="checkbox"/> Entity Status Has Changed	<input type="checkbox"/> Darby & Darby, PC
Client Ref No: FB91003RUS						<input type="checkbox"/> Not Responsive

Return to: Polly Stevens  
Fax: (212) 527-7701  
Number of Pages:

Number of Pages

**Client Number: 09450 - Kabasawa & Associates**

**Client Number: 09450 - Kabasawa & Associates**

[illegible]

4 Records for: 09450

*Bob K.*

Satoshi KABASAWA  
KABASAWA & ASSOCIATES



# **EXHIBIT B**

[illegible]

# EXHIBIT C

IN ACCOUNT WITH

**DARBY &  
DARBY**

PROFESSIONAL  
CORPORATION

INTELLECTUAL PROPERTY LAW

NEW YORK

805 THIRD AVENUE  
NEW YORK, NY 10022  
TEL: 212.627.7700  
FAX: 212.627.7701

SEATTLE

1191 SECOND AVENUE  
SEATTLE, WA 98101  
TEL: 206.262.8900  
FAX: 206.262.8901

FEDERAL ID NO. 13-2768173

Invoice Date: August 31, 2006

Invoice No.: 691994

Kabasawa & Associates  
The NSO Building  
1-22, Shinjuku, 3-Chome  
Shinjuku-Ku, Tokyo 160, Japan

Client No: 09450

For Professional Services Rendered Through August 31, 2006, in Connection with the Following  
Matter:

9509450-000

**MAINTENANCE FEES/RENEWALS**

**Costs Advanced**

08/31/06	Maintenance Fees/Renewals	1,212.00
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<b>Total Costs Advanced</b>		<b>\$ 1,212.00</b>
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<b>Invoice Total</b>		<b>\$ 1,212.00</b>
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# EXHIBIT D

Melvin C. Garner

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**From:** OKITA [okita@kabasawa.com]  
**Sent:** Wednesday, October 20, 2010 1:37 AM  
**To:** agogoris@merchantgould.com; ludwig@fr.com; Melvin C. Garner  
**Cc:** KABASAWA satoshi; KABASAWA & Associates  
**Subject:** Status of the maintenance fee payment for U.S. Patent No. 6,561,716 (Darby's Ref.: 9450/0K683US0, Our Ref.: FB01003PUS)  
**Attachments:** Invoice and Acknowledgement.pdf; Our Instructions.pdf  
**Importance:** High

Dear Sirs,

With respect to the above-mentioned U.S. Patent No. 6,561,716 (Darby's Ref.: 9450/0K683US0, Our Ref.: FB01003PUS), we noticed that it has already expired in 2007 due to non-payment of maintenance fees.

We are very surprised because we have already instructed Darby & Darby to proceed with payment of the maintenance fee, and have transferred payment soon after that. We didn't know the patent has already expired until recently, as we haven't received any notices informing us of the expiration of the patent (i.e. a Notice of Patent Expiration) from Darby & Darby.

For your information, we enclosed herewith the invoice and acknowledgement of our instructions for this case as the file attachments.

Please explain why the maintenance fee was not paid in spite of our instructions. At the same time, since our client consider this right to be important, please let us know if we can revive this patent or not.

Looking forward to hearing from you.

Yours sincerely,

Chika OKITA (Ms.)  
for Satoshi KABASAWA

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KABASAWA & ASSOCIATES  
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